

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Application Number 10/664,486

Filed September 17, 2003

Inventor Daniel A. Petito

Art Unit 3629

Examiner K. Evans

Confirmation 4365

Docket Number 1074 003 301 0202

- Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.
- This request is being filed with a notice of appeal.
- The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided

I am the

- applicant/inventor.
- assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- attorney or agent of record.  
Registration number 34,545.
- attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_.

Signature Duane C. Basch, Esq. Reg. No. 34,545/Typed or Printed Name Duane C. BaschTelephone Number 585-899-3970Date August 25, 2010

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required,

**REMARKS & ARGUMENTS IN SUPPORT OF WITHDRAWAL OF REJECTIONS**

*Clarification of Record*

This is an appeal of the Final Rejection dated May 27, 2010. In the Office Action dated Nov. 27, 2009, claims 1 – 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Raveis, JR US Patent Application Publication US2001/0005829A1; in view of Hibbert et al., US Patent Application Publication No US2006/0074793A1. In the Final Office Action dated May 27, 2010, the sole rejection of claims 1-20 is under 35 U.S.C. §103(a) as being unpatentable over Raveis, JR US Patent Application Publication US2001/0005829A1; in view of Hibbert et al., US Patent Application Publication No US2006/0074793A1. Nonetheless, the Final Office Action (p. 14) indicated that Applicants' arguments were "moot in view of the new ground(s) of rejection." As no new grounds for rejection are believed to have been presented in the Final Office Action, Applicants respectfully urge that the record reflect that this was a Final Action based upon the same grounds of rejection. The Finality of the Final Rejection remains both premature and deficient, for the reasons discussed more specifically below as well as the continued failure to clearly indicate the basis for rejection of claims 12-15, which again appear to rely upon the reference Almeida that is not cited as a basis for the rejection of claims 1 – 20.

Furthermore, Applicants previously asserted that the Office Action of Nov. 27, 2009 was deficient because it failed to set forth a particular basis for rejection for apparatus claim 7 and method claim 17, and as a result *prima facie* obviousness had not been established for all independent claims. Rather than correcting the rejection and allowing Applicants an opportunity to respond fully to rejections of claims 7 and 17, the Examiner merely responded to Applicants' previous arguments stating that, "**while claim 1 appears to be a more narrow scope than claim 7**, the independent system claims 1 and 7 recite very similar limitations and therefore the rejections for claims 1 and 7 limitations are combined in an effort to expedite prosecution of the application. Amended independent method claim 17 while still similar to the system claims 1 and 7, has been rejected separately from claims 1 and 7. **Detailed explanations are given in the preceding sections of the present Office Action.**" (emphasis added)

Applicants have, therefore proceeded with the instant appeal and request that the Pre-

Appeal conferees provide a full and thorough consideration to all arguments presented herein.

*Response to Remaining Rejection(s)*

The sole rejection in this application is a rejection of claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over Raveis, JR (US2001/0005829; "Raveis") in view of Hibbert et al., (US2006/0074793; "Hibbert"). The rejection under 35 U.S.C. §103(a) is again traversed for at least the reasons set forth below.

First, Applicants respectfully challenge the merits for combining Raveis and Hibbert. As a basis for the combination the Examiner has asserted the combination, without support, because: a) the proposed combination would "provide an efficient process for automation of various deal management, collateral analysis and processes associated with financial transactions..." (Final Action, p. 6); b) "because it is an efficient means for providing links to documents and data associated with a transaction" (Final Action, p. 8); c)... the Network services gateway is an efficient means for validating responses from external services against the Document Type definitions" (Final Action, p. 8); d) "... it is an efficient means for providing information relative to the data fields and operator descriptions which can be queried in the database" (Final Action, p. 9); and e) it would have been obvious to combine "... the method for creating and maintaining worldwide e-commerce of Almeida because it is an efficient means for providing the ability to exchange interfaces uploaded by a user or allow the user to select one provided by a host computer." (Final Action, p. 11). Applicants respectfully submit that the Examiner has, with great confusion, indicated a plurality of bases for the alleged combination, but has failed to show that any one of them would have been considered by one of ordinary skill in the art. Moreover, one of the bases apparently relies upon a reference not made part of the rejection. Absent any support for the alleged bases asserted, at most they are merely conjecture set forth by the Examiner in a post-invention reconstruction of the claims. For these reasons, the combination is improper and the conferees are respectfully requested to withdraw the rejection.

Second, Applicants respectfully note that even if the arguable combination is considered the Examiner has, once again, failed to establish a teaching of each of the recited limitations set forth in the independent claims 1, 7 and 17. As now acknowledged by the Examiner, Raveis does not teach a database having a first table with embedded rules that define a workflow or a second table defining at least one attribute of a display of information as recited in rejected

claims 1 and 7. Nor does Raveis describe following a work-flow for a transaction defined by at least embedded rules in a first database table, providing access to the database for the plurality of users, via a user interface, and dynamically controlling the user interface as a function of data stored in the second table as set forth in claim 17.

Applicants continue to urge that Hibbert, either alone or in combination with Raveis, also fails to teach the limitations in claims 1, 7 or 17. With respect to the Examiner's allegation that Hibbert's disclosure of a transaction management system 50 results in a teaching of the noted limitations of claims 1, 7 or 17, Applicants respectfully urge that no such teaching has been established. At page 6 of the Final Office Action, the Examiner has apparently pronounced, without support, that "the work flow management engine characterizes 'embedded rules'." Again, he Examiner fails to provide support for such an interpretation. Similarly, the Examiner urges that "the generation of HTML pages, describes at least a second table based on attributes selected by a user," again without support for such an interpretation.

In fact, as the Examiner has characterized Hibbert the publication would appear to teach away from the claimed invention. More specifically, at p. 4 of the Office Action the rejection indicates that "each work flow comprises a set of **predefined** transaction events and associated actions that work flow management engine 52 executes in response." (emphasis added) On the contrary, the claimed invention does not require pre-defined workflows, but uses rules that are embedded within a database table, and are therefore dynamic. Hibbert's reliance upon predefined transaction events that are executed by a workflow management engine are thus contrary to the dynamically adjustable workflow that results when the rules are embedded within a database table as presently recited in the claims. This is further confirmed by Hibbert's disclosure (para. 0028) that "[a]s discussed in more detail below, transaction management system 50 implements software components and interfaces facilitating management of work flows associated with financial transactions" thus suggesting that the workflows are encoded in software.

With respect to the limitation of "a second table defining at least one attribute of a display of information associated with said property transaction" (e.g., claim 1), the Examiner appears to rely on Figs. 4-7 and paragraphs 32 and 51 of Hibbert. While Hibbert discloses several features, Applicants are again unable to understand just where the specific claim limitations are disclosed. Hibbert does not appear to teach a second table defining an attribute of a display as required by the claims.

Applicants further refer the conferees to the specification of the instant application, for example, pages 2-3, 6, 9-11, where the particular application of the claimed features are further

characterized.

Of further note is the fact that the rejection fails to indicate where the recited tables with embedded rules and attributes of a display are disclosed as being found within a database (or the use of such tables as currently recited in claim 17). Apparently recognizing the deficiencies in the rejection the Examiner urges, again without support, that "[i]t is old and well known in the art of computer science that workflows are used to define a pre-defined set of rules and that computers are used for automating these workflows." Applicants respectfully request that the Conferees withdraw the rejection in light of the Examiner's failure to substantiate such an assertion. Furthermore, even if substantiated, the use of rules still fails to teach or suggest the specific limitations as set forth in the claims (e.g., rules embedded in database tables).

Again, Applicants respectfully challenge the Examiner's interpretation and further submit that even if substantiated, the Examiner's interpretation is contrary to the claim language – where the embedded rules are found in a database table (and are not hard-coded in a work flow management engine).

Finally, apparently as an alternative justification for ignoring specific limitations of the independent claims, the Examiner urges that the recited "contents of the database" are considered non-functional descriptive language. Again Applicants respectfully challenge such an interpretation. Applicants note that claims 1 and 7 include the limitations in a manner that alters the recited structural elements (e.g., operation on work-flow defined by embedded rules; user interface dynamically controlled as a function of attributes) and that previously amended method claim 17 expressly indicates that the embedded work-flow rules and attributes of a display are indeed functionally involved in the steps recited. Moreover, the use of database tables in such a fashion is a new and non-obvious application or use of such tables – as further evidenced by the Examiner's failure to identify such use in any references.

#### *Conclusion*

In view of the various arguments set forth above, Applicants respectfully request that the rejection of claims 1, 7 and 17 be withdrawn and the claims indicated as allowable.

**PATENT APPLICATION NUMBER: 10/664,486**

Attorney Docket Number: 1074 003 301 0202

With respect to dependent claims 2-6, 8-16 and 18-20, for purposes of brevity Applicants have not set forth specific arguments in traversal of the rejection of these claims. However, Applicants reserve the right to separately argue the merits of such claims in the appeal brief in the event the rejection is maintained.

Respectfully submitted,

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